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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,498	03/26/2004	Mitsuaki Oshima	28951.2011C12	7864
27890 7590 10/28/2010 STEP TOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036				
EXAMINER				
WEST, THOMAS C				
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3621				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,498

Applicant(s)

OSHIMA ET AL.

Examiner

THOMAS WEST

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29, 31, 32, 35, 36 and 38-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29, 31, 32, 35, 36, 38-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB006)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the Remarks filed on August 24, 2010.
2. Advisory Action filed October 26, 2010 is hereby withdrawn.
3. Claims 29, 31, 32, 35, 35, 38-43 are currently pending and have been examined.
4. Applicant's response filed Aug 24, 2010 is sufficient to reopen prosecution.

Claim Rejections - 35 USC § 112 2nd Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 29, 31, and 32 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 29, 31, 32:

The following elements are mean-plus function limitations that invoke U.S.C. 112, sixth paragraph:

Claim 29, "reading means for reading a cipher key...", encoding means for encoding ...", "communicating means for communicating". Claim 31, reading means for reproducing...." Claim 32, reading means for reading the certain information....".

However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function.

For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 29, 31, 32, 38 are rejected under U.S.C. §103(a) as being unpatentable over Waters, US. Patent No. 5,572,589, in view of O'Boyle et al., U.S. Patent No. 5,432,329, in view of Tanabe et al., US Patent No. 5,447,767.

Claim 29:

Waters discloses:

29. reading means for reading a cipher key and identification intonation unique to an optical disk having data recorded therein, the identification

information and the cipher key recorded on the disk wherein a reflective layer of the optical disk has been trimmed with a laser beam; (4:32-67, 5:34-67)

encoding means for encoding with the cipher key data; (1:24-35, 6:35-67)

communicating means for communicating certain information including the identification intonation and the encoded specific data to a server capable of selecting a decode key that corresponds to the identification with the selected decode key decoding the encoded data. (6:1-34 clearing house);

Waters discloses the limitations above, but does not disclose credit card information but O'Boyle does:

the specific data includes a credit card number of the user (col. 8, lines 67-69, col. 9, lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Waters to include the credit card information O'Boyle since this allows for customer identification and authorization.

Waters discloses the limitations as shown above. Waters does not directly disclose stripe patterns along a radius, but Tanabe teaches (44:2-5, 46:40-43, 26:57-69).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Waters to include the stripe patterns along a radius of Tanabe since through level slicing, coded data can be decoded and since the

concentric track on an optical disk follows along a radius as shown by the measuring of track signals along radiuses above (26:57-69).

Claim 31:

Waters discloses:

The reading means is for reproducing identification information recorded in an area overlapping a pre-pit region of a disk. (5:22-49 hub)

Claim 32:

Waters discloses:

reading means is for reading the certain information comprising a connection address of a server. (6:1-34 clearing house – inherent address)

Claim 38:

Waters discloses the limitations above, but does not disclose credit card information but O'Boyle does:

the specific data includes a credit card number of the user (col. 8, lines 67-69, col. 9, lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Waters to include the credit card information O'Boyle since this allows for customer identification and authorization.

Waters discloses the limitations as shown above. Waters does not directly disclose stripe patterns along a radius, but Tanabe teaches (44:2-5, 46:40-43, 26:57-69).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Waters to include the stripe patterns along a radius of Tanabe since through level slicing, coded data can be decoded and since the concentric track on an optical disk follows along a radius as shown by the measuring of track signals along radiuses above (26:57-69).

9. Claims 35, 41-43 are rejected under U.S.C. 103(a) as being unpatentable over Waters, US. Patent No. 5,572,589 in view of O'Boyle et al., U.S. Patent No. 5,432,329.

Claims 35, 36, 39-43:

Waters discloses:

35. said reading comprises reading identification information that has been coded in an area overlapping a pre-pit region of a disk. (col. 6, lines 1-34)

36 additionally comprising certifying certain information comprising a connection address of a server (6:1-34 clearing house – inherent address)

41 a content reproducing device reading from such an optical disk a cipher key and identification information unique to the optical disk; (4:32-67, 5: 34-67)

said content reproducing device encoding, using the cipher key, specific data; (6:35-67);

said content reproducing device communicating at least the identification information and the encoded specific data to a server having therein at least one decode key that corresponds to the identification information of the disk; (6:12-34)

said server selecting a decode key that corresponds to said identification information of said optical disk, and decoding the encoded specific data using the selected decode key. (6:12-34)

wherein said reproducing of the data of the optical disk comprises reproducing the content data of the optical disk after authentication of user (6:1-34)

Waters discloses the limitations above, but does not disclose credit card information but O'Boyle does:

39. checking the accounting information; and (8:67-69, 9:1-6)
certifying a possibility of the accounting to a user, (8:67-69, 9:1-6).
checking of the accounting information and after certifying the possibility of the accounting to a user. (8:67-69, 9:1-6).

40. the accounting information includes a credit card number of user.
(8:67-69, 9:1-6).

42. the specific data is accounting information associated with a user account. (8:67-69, 9:1-6).

43. wherein the specific data is accounting information associated with a user account. (8:67-69, 9:1-6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Waters to include the credit card information O'Boyle since this allows for customer identification and authorization.

Response to Arguments

10. Applicant's arguments with respect to claims 29, 31, 32, 35, 35, 38-43 have been considered but are moot in view of the new grounds of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas West whose telephone number is 571-270-1236. The examiner can normally be reached on Tuesday and Wednesday 7:30am - 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas West
Patent Examiner
Art Unit 3621

/ANDREW J. FISCHER/
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